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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 059864.01866
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: 10/562,566 Filed: March 6, 2006 First Named Inventor: Jan CHIPCHASE *et al* Art Unit: 2617 Examiner: Fred A. Casca

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ Applicant/Inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96)

☒ Attorney or agent of record.
Registration No. 58,178

☐ Attorney or agent acting under 37 CFR 1.34.
Registration Number if acting under 37 CFR 1.34 _____

/Peter Flanagan/
Signature

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Typed or printed name

703-720-7864
Telephone number

May 25, 2011
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	Confirmation No.: 7877
Jan CHIPCHASE *et al.*	Art Unit: 2617
Application No.: 10/562,566	Examiner: Fred A. Casca
Filed: March 6, 2006	Attorney Dkt. No.: 059864.01866

For: CUSTOMIZATION OF AN ELECTRONIC DEVICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 25, 2011

Sir:

Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 1, 3-10 and 50-61 in the Office Action dated January 25, 2011. Applicants filed a Response to the Final Office Action on April 25, 2011, and the Office issued an Advisory Action dated May 16, 2011, maintaining the final rejections. Applicants submit this Pre-Appeal Brief Request for Review with a Notice of Appeal.

Claims 1, 3-10, and 50-61 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 6,728,712 ("Kelley") in view of U.S. Patent No. 6,782,253 ("Shteyn"), and further in view of U.S. Patent Publication No. 2002/0156832 ("Duri"). Applicants respectfully submit that this rejection contains at least two clear errors: (1) the rejection is plainly an inappropriate use of hindsight reconstruction without proper motivation in the knowledge of one of ordinary skill in the art, and (2) "a communication that automatically alters the network address associated with a tag in dependence on the estimated location" (as recited in the present claims) is missing in the prior art.

Clear Error 1: Rejection is Plainly an Unmotivated Hindsight Reconstruction

Kelley discusses a client's bookmark database of URLs of files on a network. To avoid the problem of "file not found," when the URL of the file is changed, Kelley indicates that the bookmark database would be updated.

Shteyn relates to a system alerts a mobile user of a service using a local beacon. The local beacon sends what Shteyn calls a "facilitation signal," which is received by the mobile user's device. A user profile in the mobile device controls whether the user of the mobile device is actually alerted.

Duri relates to what Duri refers to as "dynamic bookmarks," which are unlike conventional bookmarks that have a URL. The "dynamic bookmarks" of Duri are a set of attributes that can be used to obtain a URL. A client sends the attributes to a server and the server replies with a URL or URLs, if any match the attributes in the client's request.

These largely unrelated references are proposed in the Office Action as disclosing (claim 1) an apparatus including at least one processor and at least one memory including computer program code, the at least one memory and the computer program code configured to, with the at least one processor, cause the apparatus to perform the following:

- store a set of tags and for each tag, store an associated network address, wherein each tag corresponds to a service and wherein the associated network address corresponds to a service provider of the service,
- provide a user interface that enables a user to select one of the tags and cause the apparatus to initiate a connection to the network address associated with the tag,
- estimate the location of the apparatus,
- communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location, and

- automatically alter the network address associated with the tag in response to the communication received from the network.

The Office Action alleged that the "tag" in claim 1 is a bookmark in which the "associated network address" is the URL, and that the user of Kelley's system can select a bookmark and initiate a connection to the URL listed for that bookmark.

However, there is absolutely no reason in the prior art for estimation of location of the device to be added to Kelley's system, or for any of the other features of the claim to be performed as a consequence of such estimation.

The Office Action cited to Shteyn, but Shteyn's approach has nothing to do with updating bookmarks like those of Kelley. Even if Shteyn discloses estimating a location, Shteyn does not disclose the remaining features because Shteyn does not disclose updating bookmarks (allegedly corresponding to the recited "tags").

The Office Action also cited to Duri, but Duri disparages using bookmarks in favor of using "dynamic bookmarks." (see paragraph [0024] of Duri). If Duri's bookmarks were substituted for Kelley's bookmarks, then Kelley's bookmarks would no longer include a network address, since Duri's bookmarks do not contain such an address.

Moreover, Duri nowhere suggests altering a network address associated with a bookmark (whether conventional or "dynamic"). Accordingly, even if Duri could somehow be combined with Kelley and Shteyn, the combination would still not disclose or suggest all of the elements of the claims.

It is respectfully submitted that the features of the claims have been improperly dissected, in the Office Action, and subjected to a piecemeal rejection, rather than being treated as a whole. MPEP 2142 notes that *prima facie* obviousness requires consideration of the invention as a whole. It is respectfully submitted that there is no way that the invention as a whole could be derived from the teachings of Kelley, Shteyn, and Duri. There is nothing to lead one of ordinary skill in the art to make the modifications necessary to arrive at the claimed invention except Applicants' own disclosure.

This was explained at much greater length in Applicants' Response filed April 25, 2011, pp. 2-14. In response, the Advisory Action of May 16, 2011, provided some additional arguments in support of the rejection. However, the Advisory Action's reasoning is equally subject to clear error.

The Advisory Action asserted that Shteyn provides an XML document that includes URLS for services, and that the XML document is generated based on geographic information. Even assuming that this is true, it has nothing meaningful to do with what Kelley is doing. There's no obvious connection to what Kelley is doing and no obvious way to combine the teachings of the two documents. The only reason Shteyn and Kelley would be combined in the way proposed is simply Applicants' own disclosure. Such a reason is legally insufficient.

The fact that both systems relate to the use of URLs is no basis for one of ordinary skill in the art to combine their teachings in any particular way. Such a basis leads to no specific combination. Moreover, the Office Action and Advisory Action have not merely argued for a simple combination of Kelley and Shteyn, but a modification of Kelley in which certain aspects of Shteyn are taken and others are not. Motivation for such a modification cannot come from the bare fact that Shteyn mentions URLs.

Clear Error 2: Shteyn Does not Teach Altering Addresses Associated with Tags

The Advisory Action alleged that "Shteyn further teaches the feature of changing URL based on location (through GPS estimation)." This is a clear error. There is no discussion in Shteyn about changing a URL based on location. The Response filed April 25, 2011, dealt with the passages of Shteyn cited in the Office Action, but a very simple point can be made this way:

Claim 1 requires: "a communication that automatically alters the network address associated with a tag in dependence on the estimated location." There is no such communication in Shteyn. The Office Action has not identified such a communication, the Advisory Action has not identified such a communication, and such a communication

cannot be found in Shteyn or any of the other prior art of record. It cannot be pointed out, because it does not exist in the prior art.

As explained in more detail in the Response filed April 25, 2011, the same or similar clear errors apply to each of independent claims 1, 8, 50, 57, 60, and 61. It is, therefore, respectfully requested that the rejection of claims 1, 8, 50, 57, 60, and 61 be withdrawn. Claims 3-7, 9, 10, 51-56, 58, and 59 depend respectively from, and further limit, claims 1, 8, 50, and 57. Thus, each of claims 3-7, 9, 10, 51-56, 58, and 59 recites subject matter that is neither disclosed nor suggested in the prior art. Accordingly, it is respectfully requested that the rejection of claims 3-7, 9, 10, 51-56, 58, and 59 be withdrawn.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

/Peter Flanagan/

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Enclosures: PTO/SB/33 Form; Notice of Appeal; Petition for Extension of Time